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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,272	03/27/2001	Scott McKay	B16.2-9822	9236

490 7590 05/29/2003

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

HRUSKOCI, PETER A

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 05/29/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,272

Applicant(s)

MCKAY, SCOTT

Examiner

Peter A. Hruskoci

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 13-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/31636 McKay in view of Jansen. McKay disclose (see pages 10-16) the structure of the cooling and water treatment systems substantially as claimed. The claims differ from McKay by reciting that the titanium electrode coated with ruthenium. Jansen disclose (see col. 5 line 39 through col. 6 line 14) that it is known in the art to utilize a titanium electrode with an iridium or ruthenium coating in a system for disinfecting water. It would have been obvious to one skilled in the art to modify the systems of McKay by utilizing the recited titanium electrode in view of the teachings of Jansen, to aid in disinfecting the water. With regard to claims 27-29, the intended use of the system fails to further limit the structure of the recited system.

3. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/31636 McKay in view of Jansen as above, and further in view of Humphrey et al.. The claims differ from the references as applied above by reciting that the system further includes an ozonator. Humphrey et al. disclose (see col. 3 lines 8-53) that it is known in

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the art of water treatment to utilize a ozonator in a cooling water system to inhibit deposit formation on surfaces in contact with the cooling water. It would have been obvious to one skilled in the art to modify the references as applied above by utilizing an ozonator in system in view of the teachings of Humphrey et al., to inhibit deposit formation in the system.

4. Applicant argues that Jansen teaches a mixture of ruthenium oxide and titanium oxide but it is asserted that Jansen discloses that it is known in the art to utilize a titanium electrode with an iridium or ruthenium coating in a system for disinfecting water. It is submitted that the titanium electrode coated with ruthenium as recited in the instant claims appears to include elemental ruthenium and ruthenium compounds such as ruthenium oxide. It is further submitted that a titanium electrode coated with a mixture of ruthenium oxide and titanium oxide, or another suitable coating as disclosed in Jansen would be considered patentably indistinguishable from the titanium electrode recited in the instant claims.

5. Applicant argues that there is insufficient motivation to make the combination of McKay and Jansen, because Jansen deals with a different kind of water treatment. It is submitted that the specific water being treated is a method or functional limitation which fails to further limit the structure of the instant system claims. It is noted the Jansen is not

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limited to drinking or swimming pool water, and fails to exclude the treatment of cooling water. Furthermore, applicant has not presented sufficient factual evidence to support the above argument.

6. Applicant argues that the intended use of claims 26-29 does limit the structure when elements of the structure of the system which define the intended use are in the claim, as with the present claims. With regard to claim 26, it is submitted that McKay is drawn to an evaporative cooling system of the type recited in the instant claim. It is submitted that the intended use as recited in claims 27-29 fails to positively recite structure to further limit the system recited in the claims.

7. Applicant's arguments concerning Humphrey et al. are based on the propriety of the combination of McKay and Jansen. This combination is deemed properly applied for reasons stated above.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter A. Hruskoci whose telephone number is (703) 308-3839. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. David Simmons, can be reached on (703) 308-1972. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.


Peter A. Hruskoci
Primary Examiner
Art Unit 1724

P. Hruskoci
May 27, 2003